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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/577,610
Filing Date: September 25, 2006
Appellant(s): GENDELMAN, SIMCHA

Gerald T. Shekleton
Registration No. 27,466
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 6, 2011, appealing from the Office action mailed January 7, 2011.

(1) Real Party in Interest

Appellant's statement identifying by name the real party in interest contained in the brief is correct.

(2) Related Appeals and Interferences

Examiner is not aware of any appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

Appellant's statement of the status of claims contained in the brief is correct. This appeal involves claims 11-14, 16-17, 19-20, and 23-30, where claim 11 is independent claim, and claims 12-14, 16-17, 19-20, and 23-30, are dependent claims.

(4) Status of Amendments

Appellant's statement of the status of amendments contained in the brief is correct. All amendments are entered and no amendments are pending.

(5) Summary of Claimed Subject matter

Appellant's summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

Appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Claims Appendix section of Appellant's brief is correct.

(8) Evidence Relied Upon

7,292,999 B2	Hobson	11-2007
2002/0026418 A1	Koppel	02-2002

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

- The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in § 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- Claims 11-14, 16, 19-20, and 25-29, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hobson (7,292,999 B2) in view of Koppel (2002/0026418 A1).

As to claim 11, Hobson shows an input device (Hobson: col. 6, lines 38-59) receiving prepaid card identification indicia (Hobson: col. 8, lines 61-67; and col. 9, line 1), in a form different from a credit card number (Hobson: col. 13, lines 1-16), from a prepaid card issued to a customer by a prepaid card issuer when said prepaid card is presented in payment by said customer (Hobson: col. 14, lines 61-67), a credit card account identified by a credit card number (Hobson: col. 5, lines 5-11); and a processor, identifying said credit card number by using said prepaid card identification indicia, said credit card number being different from said prepaid card identification indicia, and to communicating said credit card number to a credit card server which processes a credit card transaction, charging said payment to said credit card account (Hobson: col. 5, lines 5-11; col. 14, lines 40-67; col. 15, lines 1-32; and col. 16, lines 14-16).

Hobson does not show said prepaid card issuer having a credit card account. Koppel shows said prepaid card issuer having a credit card account (Koppel: page 2, ¶ 38). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Hobson by said

Art Unit: 3691

prepaid card issuer having a credit card account of Koppel in order to provide a type of electronic cash which can be used anonymously (Koppel: page 1, ¶ 15).

As to claim 12, Hobson in view of Koppel shows all the elements of claim 11. Hobson also shows that said input device is a card reader (Hobson: col. 14, lines 47-50).

As to claim 13, Hobson in view of Koppel shows all the elements of claim 11. Hobson also shows that said input device is a keyboard (Hobson: col. 6, lines 38-40).

As to claim 14, Hobson in view of Koppel shows all the elements of claim 11. Hobson also shows that said processor is operative to verify validity of said prepaid card identification indicia prior to processing said credit card transaction (Hobson: col. 13, lines 1-14).

As to claim 16, Hobson in view of Koppel shows all the elements of claim 11. Hobson also shows a communicator, operative to communicate said prepaid card identification indicia to a remote server to determine validity of said prepaid card (Hobson: col. 14, lines 47-54).

As to claim 19, Hobson in view of Koppel shows all the elements of claim 11. Hobson also shows a storage device for storing said credit card number (Hobson: col. 5, lines 8-11; note that this is a statement of intended use or a field of use).

As to claim 20, Hobson in view of Koppel shows all the elements of claim 11. Hobson also shows that said point of sale terminal receives, from a remote server, said credit card number (Hobson: col. 5, lines 8-11 and 23-25; and Hobson: col. 13, lines 1-16).

As to claim 25, Hobson in view of Koppel shows all the elements of claim 11. Hobson also shows that said processor enables said credit card number to be accessed at said point of sale terminal using said prepaid card identification indicia (Hobson: col. 13, lines 1-16).

As to claim 26, Hobson in view of Koppel shows all the elements of claim 11. Hobson also shows that said processor enables said credit card number to be identified at said point of sale terminal by accessing a lookup table based on said prepaid card identification indicia (Hobson: col. 15, lines 1-10).

As to claim 27, Hobson in view of Koppel shows all the elements of claim 16. Hobson also shows that said credit card number is stored at said remote server (Hobson: col. 5, lines 8-11; and Hobson: col. 13, lines 1-16).

As to claim 28, Hobson in view of Koppel shows all the elements of claim 16. Hobson also shows that said processor enables said credit card number to be accessed at said remote server using said prepaid card identification indicia (Hobson: col. 5, lines 8-11; and col. 13, lines 1-16).

As to claim 29, Hobson in view of Koppel shows all the elements of claim 16. Hobson also shows that said processor identifies said credit card number by sending said prepaid card identification indicia to a remote server which includes a lookup table (Hobson: col. 15, lines 1-10).

- Claims 17 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hobson in view of Koppel, and further in view of Zampese (6,014,650).

As to claim 17, Hobson in view of Koppel shows all the elements of claim 16. Hobson in view of Koppel does not show that said remote server communicates information regarding a balance remaining on said prepaid card, via said communicator, to said terminal. Zampese shows that said remote server

Art Unit: 3691

communicates information regarding a balance remaining on said prepaid card, via said communicator, to said terminal (Zampese: col. 5, lines 15-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Hobson in view of Koppel by said remote server communicating information regarding a balance remaining on said prepaid card, via said communicator, to said terminal of Zampese in order to check the sufficiency of the funds available (Zampese: col. 5, lines 15-16).

As to claim 30, Hobson in view of Koppel shows all the elements of claim 16. Hobson in view of Koppel does not show that said validity of said prepaid card relates to balance information. Zampese shows that said validity of said prepaid card relates to balance information (Zampese: col. 5, lines 15-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Hobson in view of Koppel by said validity of said prepaid card relating to balance information of Zampese in order to check the sufficiency of the funds available (Zampese: col. 5, lines 15-16).

- Claim 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hobson in view of Koppel, and further in view of Spear (7,752,134 B2).

As to claim 23, Hobson in view of Koppel shows all the elements of claim 11. Hobson in view of Koppel does not show that said point of sale terminal transmits

Art Unit: 3691

information to a credit card transaction clearinghouse, said information including said credit card number. Spear shows that said point of sale terminal transmits information to a credit card transaction clearinghouse, said information including said credit card number (Spear: col. 3, lines 52-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Hobson in view of Koppel by said point of sale terminal transmitting information to a credit card transaction clearinghouse, said information including said credit card number of Spear in order to obtain approval and settlement (Spear: col. 3, line 54).

- Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hobson in view of Koppel, and further in view of Bellosguardo (7,222,097 B2).

As to claim 24, Hobson in view of Koppel shows all the elements of claim 11. Hobson in view of Koppel does not show that said credit card account is associated with a plurality of said prepaid cards. Bellosguardo shows that said credit card account is associated with a plurality of said prepaid cards (Bellosguardo: col. 4, lines 40-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Hobson in view of Koppel by said credit card account being associated with a plurality of said prepaid cards of Bellosguardo in order to provide anonymous purchase of goods or services (Bellosguardo: col. 4, line 64).

(10) Response to Arguments

Appellant argues that “in Koppel, as distinct from the present invention, there is no need for the processor to identify a credit card number associated with a credit card account belonging to a credit card issuer, and indeed in Koppel the processor does not identify a credit card number associated with a credit card account belonging to a credit card issuer.” Applicant further argues that “in contrast to the recitation of claim 11 ... in Koppel the prepaid card identification indicia is communicated to the credit card server, not the credit card number of the issuer credit card account being charged” because “it is this valid credit card number of the issuer credit card account being charged.” Examiner respectfully disagrees with Applicant’s argument that Hobson modified by Koppel does not disclose each and every element of the independent claim 11.

Contrary to Applicant’s arguments, Examiner never stated that Koppel discloses the processor identifying a credit card number associated with a credit card account belonging to a credit card issuer. Examiner, however, stated that Hobson discloses all the other elements of the claim 11 except “prepaid card issuer having a credit card account.” Examiner then used Koppel to modify Hobson showing “prepaid card issuer having a credit card account.”

Hobson specifically discloses “the user may interact with the host system’s transaction system or a merchant via **any input device** such as telephone, keyboard, mouse, kiosk, personal digital assistant” (Hobson: col. 6, lines 38-44; disclosing “an input device”), “smart card 14, as defined herein, includes any type of transaction, authentication, and/or financial instrument, e.g., charge card, credit card, loyalty card, identification card, stored value card, and/or the like, that is capable of storing, generating, and/or **transmitting** digital certificates or other **authentication information** so that the host system 300 and/or merchant 200 is able to better authenticate and identify the user 1” (Hobson: col. 8, lines 61-67; and col. 9, line 1; disclosing “receiving prepaid card identification indicia”), “the host system 300 challenges the user 1 for authentication information by presenting the user 1 with an authentication window 320 where the user is prompted to insert his or her smart card 14 and **enter the appropriate PIN**” (Hobson: col. 13, lines 3-7; disclosing “in a form different from a credit card number”; see further col. 11, lines 6-10 where Hobson discloses “the card provider/product identifier, e.g., BIN range, first 6 digits, and/or like, **numbers may be different so as to differentiate the STNs from regular charge card numbers**”, and where “STN” is “secondary transaction number”), “the user 1 is challenged to **insert his or her smart card 14 into the smart card reader 12 and enter the appropriate PIN**” (Hobson: col. 14, lines 61-67; disclosing “from a prepaid card issued to a customer by a prepaid card issuer when said prepaid

Art Unit: 3691

card is presented in payment by said customer”), “this invention generally involves the host system 300 identifying and authenticating the user 1 and then retrieving the **user’s account information, e.g., credit card number**, from a host system database” (Hobson: col. 5, lines 5-11; disclosing “a credit card account identified by a credit card number”), “the SCP [Smart Card Payment] system 330 the obtains the user 1 account information from the digital security system 350 [and] calls the secondary transaction number (STN) system, [where] STN system 360 interfaces with the user database system 340, where **the STN is generated and associated with the user’s designated account**” (Hobson: col. 15, lines 32-40; disclosing “a processor, identifying said credit card number by using said prepaid card identification indicia, said credit card number being different from said prepaid card identification indicia”), and “once the secondary transaction number is accepted by the merchant 200, the **transaction process is complete**” (Hobson: col. 16, lines 14-16; disclosing “communicating said credit card number to a credit card server which processes a credit card transaction, charging said payment to said credit card account”).

Hobson is then modified by Koppel disclosing specifically that “the issuing bank is a bank or other financial institution which participates in an existing network of credit cards such as MasterCard or Visa,” where “the issuer of the electronic cash contracts with the issuing bank for an account” and where “the issuing bank provides a main account whose terms are between issuer and the issuing

Art Unit: 3691

bank” (Koppel: page 2, ¶ 38; disclosing “prepaid card issuer having a credit card account”).

Therefore, Hobson modified by Koppel discloses each and every element of the independent claim 11.

(11) Evidence Appendix

No evidence is identified by Examiner in the Evidence Appendix section of Appellant's brief.

(12) Related Proceedings Appendix

No decision rendered by a court or the Board is identified by Examiner in the Related Proceedings Appendix section of Appellant's brief.

Art Unit: 3691

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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